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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,165	12/15/2003	Martin J. Dowling	I-2-0585.1US	4418

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VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER

BALAOING, ARIEL A

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,165

Applicant(s)

DOWLING, MARTIN J.

Examiner

Ariel Balaoing

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 19 recites the limitation "the communications transceiver" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 7-11, 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by OSBORN (US 6,119,022).

Regarding claim 1, OSBORN discloses a silent alerting system comprising: a wearable device (16-Figure 1; column 4:lines 31-45) comprising: a vibrator (column 6:lines 49-60); a receiver that activates the vibrator upon receiving a predetermined signal (abstract; column 5:lines 5-36; column 6:lines 49-60); a power supply that powers the vibrator and receiver (column 5:lines 5-36); and a communication device (10, 14-Figure 1) comprising: a mechanism to link to a wireless network (column 4:lines 31-45);

a screening mechanism to accept a call of a predetermined classification (column 6:lines 35-48); and a mechanism to silence said communication device, record a message, and send the predetermined signal to said receiver upon receipt of said accepted call of a predetermined classification (column 6:line 35-column 7:line 43).

Regarding claim 2, OSBORN discloses a wireless transmit/receive unit (WTRU) comprising: a communications transceiver to communicate with a wireless network in accordance with network protocols (column 4:lines 15-45; as a cell phone in used in the specification, the device inherently includes a means for communicating with a wireless network in accordance with a network protocol); a local radio link transmitter, receivable by a remote signaling unit, for providing a user with an indication of an incoming call (column 7:lines 5-53); circuitry to discriminate between classes of incoming calls and assign priorities to the classes (column 6:lines 35-48); and circuitry to transmit data through the local radio link transmitter concerning calls in accordance with at least one assigned priority (column 6:lines 35-48).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising the local radio link transmitter further providing caller identification data for display on the remote signaling unit (column 6:lines 19-35).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising the local radio link transmitter provided as part of a transceiver, thereby permitting the user

to communicate through the WTRU by use of the local radio link (column 5:line 5-column 6:line 4).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising: the local radio transmitter provided a transceiver for providing communication with one or more remote communication units (column 5:line 36-column 6:line 4; column 7:lines 5-43); and circuitry to transmit data through the local radio link transceiver concerning calls, and to communicate with at least one of the remote communication units, thereby providing simultaneous communication between a wireless network connection and plural ones of the remote communication units (column 5:line 36-column 6:line 4; column 7:lines 5-43).

Regarding claim 8, OSBORN discloses a wearable device comprising: a receiver to receive and respond to transmissions from a local wireless phone when said phone is called (column 5:line 36-column 6:line 4; column 7:lines 5-43); a vibrator that is actuated when said receiver receives said transmission (abstract; column 5:lines 5-36; column 6:lines 49-60); and a battery to power said receiver and said vibrator, whereby a user is alerted by said vibrator when said phone is called (column 5:lines 5-36).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses additionally comprising a means to attach said wearable device in such a way as to maintain it in contact with said user's body (16-Figure 1, 3, 4; column 4:lines 31-45).

Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses additionally comprising a means to keep said wearable device in contact with said user's wrist (16-Figure 1, 3, 4; column 4:lines 31-45; the clip can also be used to keep device in contact with a user's wrist).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35).

Regarding claim 14, OSBORN discloses a wireless transmit/receive unit (WTRU) comprising: a communications transceiver to communicate with a wireless network in accordance with network protocols (column 4:lines 15-45; as a cell phone in used in the specification, the device inherently includes a means for communicating with a wireless network in accordance with a network protocol); a local radio link transceiver for communication with at least one remote communication units (column 7:lines 5-53); circuitry to transmit data through the local radio link transceiver concerning calls, and to communicate with the at least one remote communication units (column 7:lines 5-53).

Regarding claim 15, OSBORN discloses a method for providing notifications to a user comprising: using a wireless electronic device to determine a notification event (column 7:lines 5-53); and wirelessly transmitting a local signal in response to the determined notification event (column 7:lines 5-53).

Regarding claim 16, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses comprising providing a receiver capable of providing the user with a vibration signal and able to receive said local signal, thereby providing the notification signal (abstract; column 6:lines 48-60).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, OSBORN does not disclose further comprising the WTRU using a caller response in said discrimination between classes of incoming calls. BACH discloses further comprising the WTRU using a caller response

in said discrimination between classes of incoming calls (column 2:line 54-column 3:line 26). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses wherein the WTRU using CLID data in said discrimination between classes of incoming calls (column 6:line 20-48). However, OSBORN does not disclose wherein the WTRU includes a circuit which uses a caller response in said discrimination between classes of incoming calls. BACH discloses wherein the WTRU includes a circuit which uses a caller response in said discrimination between classes of incoming calls (column 2:line 54-column 3:line 26). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of CAZIER (US 2004/0100505 A1).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon regarding the subject matter this claim is dependent upon. OSBORN further discloses further comprising: an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35); and a

menu function control in communication with the local wireless phone; and a two-way voice communications capability with the local wireless phone, thereby permitting a user to communicate through the local wireless phone by use of the wearable device (column 5:line 5-column 6:line 4). However, OSBORN does not disclose a menu function control in communication with the local wireless phone. CAZIER discloses a menu function control in communication with the local wireless phone (paragraph 9, 24). Therefore it would have been obvious to a person of ordinary skill in the art to provide a menu control on the remote device in communication with the local phone, as taught by CAZIER, as this allows the user the ability to quickly change options of the remote device without the need of handling the local phone.

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon regarding the subject matter this claim is dependent upon. OSBORN further discloses comprising: an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35); and a two-way voice communications capability with the local wireless phone using a shared channel, thereby permitting one or more users to simultaneously communicate through the local wireless phone by use of the wearable device (column 5:line 5-column 6:line 4). However, OSBORN does not disclose a menu function control in communication with the local wireless phone. CAZIER discloses a menu function control in communication with the local wireless phone (paragraph 9, 24). Therefore it would have been obvious to a person of ordinary skill in the art to provide a menu control on the remote device in communication with the local phone, as taught by CAZIER, as this allows the user the

ability to quickly change options of the remote device without the need of handling the local phone.

10. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of HENRIKSSON (US 5,845,219).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although OSBORN discloses a means for differentiating call groups (column 6:lines 35-48), OSBORN does not disclose comprising: classifying at least one group of calls received from a communications system as higher priority calls; and only providing the local signal in response to receiving said higher priority calls. HENRIKSSON discloses comprising: classifying at least one group of calls received from a communications system as higher priority calls (abstract; column 1:line 50-column 2:line 9); and only providing the local signal in response to receiving said higher priority calls (abstract; column 1:line 50-column 2:line 9). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a priority to incoming calls, as taught by HENRIKSSON, as this enables the user to alert the ringer when a user defined phone number is detected.

Regarding claim 18, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, OSBORN does not disclose further comprising: classifying a second priority calls; providing at least one additional user notification signal in response to receiving the second priority calls. HENRIKSSON discloses further comprising: classifying a second priority calls (abstract; column 1:line

50-column 2:line 9; caller numbers not found on the database are classified as non priority calls); providing at least one additional user notification signal in response to receiving the second priority calls (abstract; column 1:line 50-column 2:line 9).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a priority to incoming calls, as taught by HENRIKSSON, as this enables the user to alert the ringer when a user defined phone number is detected.

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, OSBORN does not disclose wherein the classifying of the high and second priority calls utilizes a database on the communications transceiver. HENRIKSSON discloses wherein the classifying of the high and second priority calls utilizes a database on the communications transceiver (abstract; column 1:line 50-column 2:line 9; the database is utilized to differentiate between priority calls and normal calls). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a priority to incoming calls, as taught by HENRIKSSON, as this enables the user to alert the ringer when a user defined phone number is detected.

11. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of HENRIKSSON (US 5,845,219) as applied to claim 18 above, and further in view of BURGESS (US 2002/0128033 A1).

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, OSBORN does not disclose wherein the

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classifying of the high and second priority calls utilizes a database. HENRIKSSON discloses wherein the classifying of the high and second priority calls utilizes a database (abstract; column 1:line 50-column 2:line 9; the database is utilized to differentiate between priority calls and normal calls). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a priority to incoming calls, as taught by HENRIKSSON, as this enables the user to alert the ringer when a user defined phone number is detected. However, the combination of OSBORN and HENRIKSSON does not disclose wherein the database is on a radio network. BURGESS discloses wherein the database is on a radio network (paragraphs 23-25, 50, 65-68). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made modify the combination of OSBORN and HENRIKSSON to include the database on a radio network, as taught by BURGESS, as this allows the mobile device to reduce the memory needed for operation.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of HENRIKSSON (US 5,845,219) as applied to claim 18 above, and further in view of BACH et al (US 6,377,795 B1).

Regarding claim 21, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, OSBORN does not disclose wherein the classifying of the high and second priority calls utilizes a response to a query. HENRIKSSON discloses wherein the classifying of the high and second priority calls utilizes a response to a query (abstract; column 1:line 50-column 2:line 9; the database

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is utilized to differentiate between priority calls and normal calls). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a priority to incoming calls, as taught by HENRIKSSON, as this enables the user to alert the ringer when a user defined phone number is detected. However, the combination of OSBORN and HENRICKSSON does not disclose wherein the query is made to an operator making the call. BACH discloses wherein the query is made to an operator making the call (column 2:line 54-column 3:line 26). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of OSBORN HENRICKSSON to include an operator response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

HIGUCHI et al (US 6,275,690 B1) – Transmission of a predetermined message to a caller

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing
Art Unit 2683
Patent Examiner

AB


RAFAEL PEREZ-GUTIERREZ
PRIMARY EXAMINER
9/15/05